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Gerard Remkes

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EXAMINER

BASS, DIRK R

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/543,174
Filing Date: July 22, 2005
Appellant(s): REMKES ET AL.

Jocelyn D. Ram
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 11, 2011 appealing from the Office action mailed July 13, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 23-30, 35, and 39-40.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

Connell et al., US 5744027 (Connell)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 23-30, 35, 39-40** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Connell et al., US 5744027 (Connell).

3. Regarding claims 23 and 26, Connell discloses an apparatus for supplying a dialyser of a dialysis unit with a dialysing fluid (abstract, fig. 1A-B) comprising:

- a. At least one receiving unit for dialysing fluid concentrate (REF 116, fig. 1B);
- b. Means for providing water for diluting the dialysing fluid concentrate (REF 82, fig. 1A);
- c. Means for mixing the dialysing fluid concentrate and the water (REF 120, fig. 1B);

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- d. A means for supplying the dialysing fluid to the dialyser (Claim 7) and
 - e. A means for setting a dialysing fluid flow rate (col. 15, l. 65-col. 16, l. 15, col. 17, l. 33-44, and REF 500, fig. 7).
4. Regarding the limitations reciting *configured to* language, the examiner considers these to be statements with regard to the intended use and are not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (MPEP 2111.02). The examiner reminds applicant that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim (MPEP 2114).
5. Regarding claim 24, the limitations "determines the dialysis fluid flow rate..." and "configured to set..." are deemed to be statements with regard to the intended use and are not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.
6. Regarding claim 25, Connell discloses an apparatus further comprising a means for testing the apparatus over a pre set time interval and a means for determining a volume of the at least one dialysing fluid concentrate in the at least one receiving unit (col. 17, l. 22-47 and REF 500, fig. 7).
7. Regarding claim 27, Connell discloses means for discharging the pre-set residual volume of the dialysing fluid concentrate to waste via a waste discharge outlet (REF 66, 166, and 198, fig. 1A-B). The "wherein..." limitations are considered to be statements with regard to the intended use and are not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (MPEP 2111.02).

8. Regarding claim 28, Connell discloses means for mixing the pre-set residual volume of the dialysing fluid concentrate with water (REF 120, fig. 1B). The “wherein...” limitation is considered to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (MPEP 2111.02).
9. Claim 29 is considered to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (MPEP 2111.02).
10. Regarding claim 30, Connell discloses means for inputting data (fig. 7-11).
11. Regarding claim 35, Connell discloses an apparatus comprising two receiving units (REF 116, 112, fig. 1B).
12. Regarding claim 39, Connell discloses means for discharging the pre-set residual volume of the dialysing fluid concentrate to waste via a waste discharge outlet (REF 66, 166, and 198, fig. 1A-B). The “wherein...” limitations are considered to be statements with regard to the intended use and are not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (MPEP 2111.02).
13. Claim 40 is considered to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (MPEP 2111.02).

(10) Response to Argument

Applicant argues that Connell fails to disclose "a means for setting a dialysing fluid flow rate Q_{d_b} during a dialysis treatment such that at the end of the pre-set treatment period T_B , the at least one receiving unit is either empty or contains a pre-set residual volume of the at least one dialysing fluid concentrate". Applicant argues that Connell further fails to disclose "a means for setting a dialysing fluid flow rate Q_{d_v} ...such that at the end of the dialysis treatment period, the at least one receiving unit is either empty or contains the pre-set residual volume of the at least one dialysing fluid concentrate".

In response, the examiner notes that applicant uses "means plus function" language for the recitation of a 'means for setting a dialysing fluid flow rate'. According to applicant's specification, the means for setting the fluid flow rate comprises the control and calculating unit (REF 24, fig. 1), which sets the flow rate of proportioning pumps (REF 17/18/20, fig. 1). The examiner maintains that Connell discloses a means for setting a dialysing fluid flow rate, wherein said 'means' comprises a controller which controls the ultrafiltration/proportioning system of the dialysis apparatus (C15/L65 - C16/L15). Furthermore, Connell explicitly discloses that the controller controls the fluid flow rate in response to a user input (C17/L20-49). Therefore, the examiner maintains that Connell discloses the 'means for setting a dialysing fluid flow rate'.

While applicants argue that Connell does not disclose the specific function of the 'means for setting a dialysing fluid flow rate', the examiner considers such limitations to be statements with regard to the intended use and are not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must

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result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (MPEP 2111.02). The examiner reminds applicant that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim (MPEP 2114).

Furthermore, the examiner maintains that the controller of Connell is capable of performing the function recited in the claims, namely setting a specified fluid flow rate. Connell discloses a controller which is responsive to user input for controlling the dialysing fluid flow rate (C17/L20-49).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/DRB/

Dirk R. Bass

Conferees:

/Benjamin L. Utech/

Primary Examiner

/Vickie Kim/

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Supervisory Patent Examiner, Art Unit 1777